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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,871	03/08/2004	John T. Boatwright	1705-018	2673

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Elmer W. Galbi, Esq.  
MARGER JOHNSON & McCOLLOM, P.C.  
1030 SW Morrison Street  
Portland, OR 97205

EXAMINER

VUONG, QUOCHIE B

ART UNIT PAPER NUMBER

2685

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,871

Applicant(s)

BOATWRIGHT, JOHN T.

Examiner

Quochien B. Vuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/08/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 03/08/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

2. Claim 4 is objected to because of the following informalities: the claim is ended with a ",", instead of a ".".

Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/160,357. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claim 1, claim 1 of copending Application No. 10/160,357 encompasses all the claimed limitations including a method of determining if a use of a particular unit is fraudulent comprising the steps of monitoring the use of said particular unit, for a plurality of times that said unit is used, to collect statistics concerning the use of said particular unit over a time period having a specific length to establish a normal usage pattern for said particular unit, said pattern being established over a plurality of uses of said unit, determining if more than a predetermined deviation exists between the use of said unit during a second period of time and said normal usage pattern, taking a first type of action if said deviation is below a first value, taking a second type of action if said deviation is above said first value.

Regarding claim 2, claim 2 of copending Application No. 10/160,357 encompasses all the claimed limitations including a method for preventing unauthorized use of a particular unit comprising the steps of monitoring the use of said particular unit to collect statistics to establish a normal pattern of use of said particular unit, said pattern of use and said monitoring covering a first period of time having a specific length and covering a plurality of times said unit is used, determining if there is more than a predetermined deviation between the use of said particular unit and said normal pattern of use during a second period of time having a length equal to said specific length,

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taking a first type of action if said deviation is below a first value, taking a second type of action if said deviation is above said first value.

Regarding claim 3, claim 3 of copending Application No. 10/160,357 encompasses all the claimed limitations including a computerized system for preventing fraudulent use of a particular item, first means which monitors use of said particular item to collect statistics over a first period of time having a specific length to establish a normal pattern of use of said particular item, said specific length covering a plurality of uses of said item, second means which determines if there is more than a particular amount of deviation between use of said particular item during a second period having a length equal to said specific length and said normal pattern of use, whereby a first type of action is taken if said deviation is below a first value, and a second type of action if said deviation is above said first value.

Regarding claim 4, claim 4 of copending Application No. 10/160,357 encompasses all the claimed limitations including wherein said first means is a computer program.

Regarding claim 5, claim 5 of copending Application No. 10/160,357 encompasses all the claimed limitations including wherein said second means is a computer program.

Regarding claim 6, claim 6 of copending Application No. 10/160,357 encompasses all the claimed limitations including wherein said statistics are collected by a computer program.

Regarding claim 7, claim 7 of copending Application No. 10/160,357 encompasses all the claimed limitations including wherein said determining step is done by a programmed computer.

Regarding claim 8, claim 8 of copending Application No. 10/160,357 encompasses all the claimed limitations including wherein said unauthorized use is fraudulent.

Regarding claim 9, claim 9 of copending Application No. 10/160,357 encompasses all the claimed limitations including wherein said collecting and determining are performed by a programmed digital computer.

Regarding claim 10, claim 10 of copending Application No. 10/160,357 encompasses all the claimed limitations including method of providing security for a particular item including, monitoring use of said particular item to collect statistics over a first period of time having a particular length to establish a normal pattern of use of said particular item, said pattern covering a plurality of uses of said item, determining if there is more than a predetermined deviation between the use of said particular item during a second period of time having a length equal to said particular length and said normal pattern of use, taking a first type of action if said deviation is below a first value, taking a second type of action if said deviation is above said first value.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No.

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6,185,415 and 1-7 of U.S. Patent No. 6,505,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are broader in scope and thus encompass the subject matter already patterned.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quochien B. Vuong  
Sep. 05, 2005

**QUOCHIE B. VUONG**  
**PRIMARY EXAMINER**